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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/698,345	10/31/2003	Hidetoshi Abe	59007US002	9663
32692	7590	02/07/2006	EXAMINER	
3M INNOVATIVE PROPERTIES COMPANY PO BOX 33427 ST. PAUL, MN 55133-3427			OSELE, MARK A	
			ART UNIT	PAPER NUMBER
			1734	
DATE MAILED: 02/07/2006				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/698,345

Applicant(s)

ABE ET AL.

Examiner

Mark A. Osele

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 May 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9, 11-14, 16, 17, 19-22 and 24-29 is/are pending in the application.
- 4a) Of the above claim(s) 24-29 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-9, 11-14, 16, 17 and 19-22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

3. Claims 1-6, 8-9, 11-13, and 16-17, 19-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over McLeod et al. (US 6,450,228) in view of Clar (US 4,525,237) or Oosterlinck (US 6,187,128). As to Claim 1, McLeod et al. discloses an apparatus (Figure 1, apparatus 10) comprising a film roll (Figure 5, film roll 174) comprising a two-layer film having a first layer and a second layer for dispensing an adhesive film (Figure 7a, film 160) onto an elongated structure (Figure 7a, handrail 200) which has an elongated top surface and two shoulder portions each on an opposing side of the

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elongated top surface, the two shoulder portions defining a surface width, the apparatus comprising a mounting frame having first and second frame side panels (Figure 1, trough elements 92a and 92b) opposing each other, the frame side panels together defining a trailing end, a leading end, a top side and a bottom side for the apparatus, and bottom portions of the first and second frame side panels defining a sleeve width at least as wide as the surface width; guide members (Figures 9a-9f, rollers 110-115) on the bottom portions of the first and second frame side panels to engage the shoulder portions of the elongated structure to allow movement of the apparatus in relation to the elongated structure while the guide members remain engaged with the shoulder portions; and a roll mounting assembly (Figure 1, spindle 64) for securely and rotatably receiving a film roll (Figure 4, film roll 174) on the top side and adjacent the leading end of the apparatus. It is noted that the curved trough elements disclosed by McLeod et al. are considered curved panels as known in the art (see US 2,934, 790; US D340,533; US 4,083,153). McLeod et al. fails to show a first layer directed in a forward direction at a separation bar while the second layer is directed in a backyard direction.

Clar and Oosterlinck each show an apparatus for dispensing an adhesive film onto a surface wherein the film roll (Clar, 30; Oosterlinck, 20) is adjacent a first end of the apparatus (Clar, near elements 36, 38; Oosterlinck, at roll 20), a separation bar (Clar, 20; Oosterlinck, 50) is adjacent an opposite end (Clar, near element 26; Oosterlinck, near element 54) of the apparatus, and the film is separated into a first layer (Clar, 14; Oosterlinck, 34) which is directed further along the direction from the film roll to the separation bar to be applied to a substrate (Clar, 52; Oosterlinck, 56) while

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the second layer (Clar, 16; Oosterlinck, 16) is directed in an opposite direction toward the first end of the apparatus (See Figs. 1 and 4 of Clar, Fig. 2 of Oosterlinck). It would have been obvious to one of ordinary skill in the art at the time the invention was made to make the apparatus of McLeod et al. with the orientation of elements shown by either Clar or Oosterlinck because Clar and Oosterlinck each show that this orientation is a functionally equivalent alternate expedient to the orientation of the analogous elements in McLeod et al.

As to Claim 2, McLeod et al. discloses an apparatus for dispensing an adhesive film (Figure 7a, film 160) comprising guide members (Figures 9a-9f, rollers 110-115) which include at least a first pair of guide rollers mounted within a sleeve, the first pair of guide rollers opposing each other and defining a channel into which the shoulder portions of the elongated structure (Figures 9a-9f, handrail 200) enter to engage the guide rollers.

As to Claim 3, McLeod et al. discloses an apparatus wherein each of the guide rollers (Figures 9a-9f, rollers 110-115) is mounted on a guide roller mounting member offset from the bottom portion of the frame side portions adjacent thereof.

As to Claim 4, McLeod et al. discloses an apparatus wherein the guide members (Figure 1, rollers 110-113) further comprise a second pair of guide rollers mounted within the sleeve, the second pair of guide rollers longitudinally offset from the first pair of guide rollers, and the first and second pairs of guide rollers together defining the channel.

As to Claim 5, McLeod et al. discloses an apparatus wherein guide rollers (Figures 9a-9f, rollers 110-115) are each mounted on a spring (Figure 11d, spring 228) such that each guide roller is movable laterally (column 9, lines 4-16).

As to Claim 6, McLeod et al. discloses an apparatus wherein the pair of guide rollers (Figures 9a-9f, rollers 110-115) are each mounted on an opposing guide roller mounting member offset from the bottom portions of the frame side panels.

As to Claim 8, McLeod et al. discloses an apparatus wherein the frame side panels (Figure 1, trough elements 92a and 92b) extend in a longitudinal direction and the film roll (Figure 4, film roll 174) has a rotating axis which, when securely received, defines a lateral direction, the film roll being fixable in the lateral direction (Figure 1, spindle 64) such that a length of film (Figure 7a, film 160) unwound from the film roll maintains a consistent lateral position in relation to the elongated structure (Figure 7a, handrail 200).

As to Claim 9, McLeod et al. discloses an apparatus wherein the film roll (Figure 4, film roll 174), when securely received, is laterally fixed in a central position such that the film (Figure 7a, film 160) unwound from the film roll maintains a central lateral position in relation to the elongated structure (Figure 7a, handrail 200).

As to Claim 11, McLeod et al. discloses an apparatus comprising a dividing panel (Figure 1, trough elements 92a and 92b) disposed across the two opposing side frame side panels such that the second layer of the film, after being separated from the first layer and directed backward to the leading end of the apparatus, is substantially prevented from contacting the top surface of the elongated structure (see Figure 5).

As to Claim 12, McLeod et al. discloses an apparatus for dispensing an adhesive film (Figure 7a, film 160) onto a top surface of a handrail (Figure 2a, handrail 200) having a handrail width, the apparatus comprising a mounting frame having first and second frame side panels (Figure 2a, trough elements 92a and 92b) opposing each other, the frame side panels together defining a trailing end, a leading end, a top side and a bottom side for the apparatus, and bottom portions of the first and second frame side panels defining a sleeve width at least the same as the handrail width; guide members (Figures 9a-9f, rollers 110-115) on the bottom portions of the first and second frame side panels to engage the shoulder portions of the handrail to allow movement of the apparatus in relation to the handrail while the guide members remain engaged with the shoulder portions; and a film roll assembly including a film roll mounting member (Figure 1, spindle 64) and a film roll (Figure 5, film roll 174) securely mounted on the film roll mounting member, wherein the film roll assembly is connected to the mounting frame on the top side of the apparatus and the film roll holds the adhesive film wrapped around an axis.

As to Claim 13, McLeod et al. discloses guide members (Figures 9a-9f, rollers 110-115) which include at least a first pair of guide rollers mounted within the sleeve, the first pair of guide rollers opposing each other and defining a channel into which the shoulder portions of the handrail (Figures 9a-9f, handrail 200) enter to engage the guide rollers.

As to Claim 16, McLeod et al. discloses an apparatus wherein the first layer is an application film to be applied on the top surface of the handrail, and the second layer is a liner layer (column 10, lines 58-67).

As to Claim 17, McLeod et al. discloses an apparatus wherein, when the two-layer film is wrapped toward the trailing end of the apparatus, the application film is on top of the liner (see Figure 5).

As to Claim 19, McLeod et al. discloses an apparatus wherein the second layer is directed toward the leading end of the apparatus through a channel adjacent to the bottom side of the mounting frame (see Figure 5).

As to Claim 20, McLeod et al. discloses an apparatus wherein the frame side panels (Figure 1, trough elements 92a and 92b) have an elongated shape extending in a longitudinal direction parallel to the handrail (Figure 2a, handrail 200) and the film roll (Figure 5, film roll 174) has a rotating axis (Figure 1, spindle 64) which, when securely received, defines a lateral direction, the film roll, when securely received, being laterally fixable in a central position such that a film (Figure 7a, film 160) unwound from the film roll maintains a consistent lateral central position in relation to the elongated structure.

As to Claim 21, McLeod et al. discloses an apparatus wherein the adhesive film has a width that matches the handrail width (column 3, lines 36-44).

As to Claim 22, McLeod et al. discloses an apparatus wherein the adhesive film has a width greater than the handrail width such that the film, when centered on the top surface of the handrail, laterally extends to cover a shoulder portion of the handrail (see Figure 5).

4. Claims 7 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over McLeod et al. (US 6,450,228) in view of either Clar or Oosterlinck as applied to claims 1 and 12 above, and further in view of Januska (US 4,775,442). As to claims 7 and 14, the references as combined do not disclose an apparatus wherein the roll mounting assembly comprises a pair of mounting walls each connected to the first and second frame side panels, the pair of mounting walls facing each other to define a receiving space to receive the film roll, wherein the film roll is adapted to hold a length of the film wrapped around an axis, and, when received in the receiving space, the film roll is rotatable to unwind the wrapped adhesive film in at least a direction toward the trailing end of the apparatus. Januska discloses an apparatus (Figure 1, applicator 10) wherein the roll mounting assembly comprises a pair of mounting walls (Figure 1, frame members 28 and 30) each connected to the first and second frame side panels, the pair of mounting walls facing each other to define a receiving space to receive the film roll (Figure 1, tape roll 12), wherein the film roll is adapted to hold a length of the film wrapped around an axis (Figure 1, spindle 39), and, when received in the receiving space, the film roll is rotatable to unwind the wrapped adhesive film in at least a direction toward the trailing end of the apparatus; the roll mounting assembly being easily accessible for the removal and replacement of the film roll. It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the apparatus of the references as combined to include a roll mounting assembly as suggested by Januska to enable a user to more easily remove and replace the film roll as necessary.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 1-9, 11-14, 16-17, and 19-22 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 1 and 12 each claim that a film roll is located at a leading end of the apparatus, a separation bar is at a trailing end of the apparatus, a direction from the leading edge toward the trailing edge is a forward direction, and a direction from the trailing edge toward the leading edge is a backward direction. These limitations are unclear because a direction from a leading edge toward a trailing edge should be a backward direction and a direction from a trailing edge toward a forward edge should be a forward direction.

Response to Arguments

7. Applicant's arguments with respect to claims 1-9, 11-14, 16-17, and 19-22 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Kuhn et al., Tsujimoto et al., Bannert, and Green each show adhesive film dispensing devices with similar arrangements of supply roll, separator bar,

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first adhesive film layer, second backing layer, and substrate to the instantly claimed invention.

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark A. Osele whose telephone number is 571-272-1235. The examiner can normally be reached on M-F 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christopher Fiorilla can be reached on 571-272-1187. The fax phone

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number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read 'Mark A. Osele', with a stylized flourish at the end.

MARK A. OSELE
PRIMARY EXAMINER

February 3, 2006